

Application No. 09/851,460
Attorney Docket No.: 9784-3U2 (TH8002US/B)

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In Re Patent Application Of :
Ulrich Reiners et al. :
Conf. No.: 4175 : Group Art Unit: 1773
Appln. No.: 09/851,460 : Examiner: Kevin R. Kruer
Filing Date: May 8, 2001 : Attorney Docket No.: 9784-3U2 (TH8002US/B)
Title: THERMO-FORMABLE MULTILAYER BARRIER FILM WITH THE
APPEARANCE AND TEXTURE OF PAPER

REQUEST FOR NEW OFFICE ACTION AFTER FINAL

This request relates to the final Office Action dated February 13, 2004 (Paper No. 20040203) in the above-identified patent application. This is not a response to the Office Action, but a request for the Examiner to specifically address the arguments and amendments set forth in the Supplemental Amendment of January 14, 2004.

The Office Action of February 13, 2004 was promptly sent to Applicants' corresponding German attorney on February 23, 2004. However, Applicants have complained that they cannot determine how to respond to the Office Action, because the Examiner has not specifically addressed the Amendment of January 14, 2004.

Paragraph 1 of the Office Action Summary states that the Office Action is responsive to the communication filed on 30 October 2003 (i.e., Applicants' Request for Reconsideration to the Office Action of April 28, 2003). The beginning of the Examiner's Response to Arguments at page 3 of the Office Action also states that Applicants' arguments filed October 30, 2003 have been fully considered, but they are not persuasive.

Applicants can find no acknowledgement or reference to the Supplemental Amendment filed on January 14, 2004. On the other hand, it appears that the Examiner did receive the Amendment of January 14, since new claims 18, 19 and 20, added by that Amendment, have been added by the Examiner to the rejections in paragraphs 3, 5, 8 and 10 at pages 2 and 3 of the

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Office Action (though without comment). The Examiner also states at the bottom of page 3 that the rejection of claim 18 (among others) over Miyazaki under 35 U.S.C. § 102(b) has been overcome by argument, but this statement is not understood, since claim 18 was not previously in the application and therefore could not have been rejected over Miyazaki.

In any event, Applicants can find no statement of the Examiner in the Office Action addressing the January 14 Amendment to claim 1 or the new claims 18-20 or addressing Applicants' remarks in support of these amendments. Therefore, Applicants have no basis on which to ascertain the Examiner's position with respect to these new and amended claims and remarks, and are thus unable to formulate a response to the February 13 Office Action.

Further, Applicants note the Examiner's acknowledgement of the failures in the teachings of Miyazaki, set forth in the paragraph bridging pages 3 and 4 of the Office Action. The Examiner concludes this listing by stating that he "will not address these arguments any further since they are deemed not [to] be relevant to the outstanding rejections." Applicants strenuously object to this position of the Examiner, because these arguments are indeed very relevant to the outstanding rejections under 35 U.S.C. § 103(a). Thus, they go to the very issue of whether it would have been obvious to combine Miyazaki with any of the other references of record, given that Miyazaki is directed to a completely different type of package, namely a cup, not a film for forming sealing packages. Therefore, Applicants request that the Examiner specifically address how Miyazaki can be used in obviousness rejections in view of these failings.

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In view of the above comments, Applicants respectfully request a new Office Action fully addressing all of the issues requested above.

Respectfully submitted,

ULRICH REINERS ET AL.

April 19, 2004 By: William W. Schwarze
(Date)

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Examiner: Mr. Kevin R. Kruer

FAX No.: 703-872-9306

Group Art Unit: 1773

Date: April 19, 2004

From: William W. Schwarze

FAX Operator:

Re: Thermo-Formable Multilayer Barrier Film with the Appearance and Texture of Paper

Application No. 09/851,460 **Filed:** May 8, 2001

Title of Paper sent via Facsimile: Request for New Office Action After Final

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